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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1961

No. 803

HARRY P. LOCKLIN and ELMER J. BRANT, general partners doing business under the firm name of Radiant Color Company,

Petitioners,

vs.

SWITZER BROTHERS, INC., a corporation,

Respondent.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI to the United States Court of Appeals for the Ninth Circuit

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The Petitioners pray for Rehearing under Rule 58(2) of this Court of the order entered April 23, 1962, denying Petitioners' prayer that a Writ of Certiorari issue to review the final decree of the United States Court of Appeals for the Ninth Circuit entered November 16, 1961.

The reason for requesting rehearing is that the claims of the Kazenas patent in suit, No. 2,809,954, were

amended to incorporate the limits of melamine in order to distinguish the same from the Japanese prior art patent at a time subsequent to Petitioners' infringing product becoming known to defendant. Specifically, the Kazenas patent claims were amended to recite that the melamine was present in an amount

> "sufficient to render (the resin) substantially insoluble in aromatic hydrocarbon solvents but insufficient to render it thermosetting."

This amendment to the claims not only distinguished the patented resin from the prior art but also described Petitioners' resin as an infringement.

No new oath was submitted with the claims as amended by defendant to include the above limitation. The new claims were first submitted to the Patent Office on May 2, 1957 (R. 753,764), or nearly two and one-half years after the original filing date. Thus Kazenas, the alleged inventor, never signed an oath setting forth that he believed himself to be the original and first inventor of the claimed invention. The patent is therefore invalid on its face in view of United States Code 35, Section 115. (Appendix A.)

In *Muncie Gear Works v. Outboard Marine & Manufacturing Co.*, 315 U.S. 759, this Court said:

> "The claims in question are invalid if there was public use, or sale of the device which they are claimed to cover, more than two years before the first disclosure thereof to the Patent Office. (Citations omitted.) Section 4886 of the Revised Statutes would in terms provide for their invalidity had they been offered by application rather than by amendment;

and whatever may be the efficacy of an amendment as a substitute for an application, it surely can effect no more than the application itself.' "

To allow the patentee to change his invention—the scope of his monopoly—by an amendment not accompanied by an oath and only after knowledge derived from petitioners is believed wholly improper and of a character to void the patent.

Respectfully,

STEPHEN S. TOWNSEND
CHARLES E. TOWNSEND, JR.
Attorneys for Petitioners.

Of Counsel:
TOWNSEND AND TOWNSEND

(Appendix Follows)

CERTIFICATE OF COUNSEL

I hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay, and that said Petition is restricted to grounds specified in Rule 58(2) of this Court's Rules.

STEPHEN S. TOWNSEND,
Attorney for Petitioner.

Appendix

§ 115. OATH OF APPLICANT

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.